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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,407	06/02/2005	Akihiro Miyashita	38036	6757
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EXAMINER HERNANDEZ, NELSON D				
ART UNIT 2622		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary

Application No.

10/529,407

Applicant(s)

MIYASHITA ET AL.

Examiner

Nelson D. Hernández

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 May 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The Examiner acknowledges the amended claims filed on May 2, 2008. Claim 3 has been amended.

Response to Arguments

2. Applicant's arguments, see page 9, filed May 2, 2008, with respect to the rejections of **claims 1-7** under 35 U.S.C. 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of a new interpretation given to previously presented prior art. The Examiner understands that the fact the in Iijima, the cut-out image appears to be a cropped image of a person does not preclude one of an ordinary in the art to have other type on images masked to be used as a background or base image without departing from the scope of the invention, therefore the Examiner is reading the base image as the cut-out image in Iijima since the base image as claimed. See rejections below.

3. Therefore, because new grounds of rejections have been made, this Office Action will be made **Non-Final**.

4. The Applicants further argue "Iijima does not disclose a plurality of types of mask images corresponding to the base image. In Iijima, since only one mask pattern corresponds to a background image, there is no chance to combine plural object images with the background image. On the other hand, in the present invention, plural mask images correspond to the base image. Therefore, it is possible, for example, to

obtain an image in which plural object images are combined into an identical background image". The Examiner disagrees. The claim as written requires a plurality of mask images corresponding to the base image, therefore, by teaching a plurality of types of mask images that can be used to create the cut-out image, Iijima et al. discloses the limitations as claimed. The limitations as written do not require that the base image has a plurality of masks in it to combine plural object images with the background.

5. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., to obtain an image in which plural object images are combined into an identical background image) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iijima et al., US Patent 6,621,524 B1 in view of Andaashu, JP 2001-285420 A.

Regarding claim 1, Iijima et al. discloses an imaging device (Fig. 1) including an image pickup unit (Fig. 1: 2) and a base image record section (Fig. 1: 14) for recording a base image (image of the user that would be cut-out), and having an image processing function of combining a picked-up image picked up by the image pickup unit and the base image to generate a composite image (this is performed by PCU 21 as discussed in col. 18, line 48 – col. 19, line 5; col. 19, lines 26-31; col. 20, lines 26-62; col. 21, lines 3-42), the imaging device comprising: a composite image record section (Flash memory 14 as shown in fig. 1; col. 5, lines 11-28; col. 6, lines 43-53) which records the composite image; a mask image data record section (Fig. 1: 14B; col. 5, lines 15-28) which records a plurality of types of mask image data representing mask images to specify a combining position of a combination object image (image of the object being picked up as shown in fig. 13A: 21) as a picked-up image to be combined with the base image (cut-out image) on the base image (the fact that in Iijima, the cut-out image appears to be a cropped image of a person does not preclude one of ordinary skill in the art to have other type of images masked to be used as a background or base image without departing from the scope of the invention) and an image pickup area for picking

up the combination object image by the image pickup unit, the mask images corresponding to the base image (Iijima et al. discloses using the mask image to create a cut-out image (interpreted as base image) of a particular image that is captured and combining said cut-out image (base) to another image that is being captured as taught in col. 18, line 48 - col. 21, line 21 referring to figs. 9 and 12A and illustrated in figs. 11 and 13; also in another embodiment Iijima et al. discloses combining the cut-out image data with previously recorded image data as taught in col. 23, line 60 – col. 25, line 30)); a reading unit (CPU 21) which reads the mask image data selected from among the plurality of types of mask image data from the mask image data record section (col. 18, line 56 – col. 19, line 5); a display unit (Fig. 1: 20) which displays the mask image based on the mask image data read by the reading unit on a display (Col. 19, lines 15-25); a combination object image holding unit which holds the combination object image which is picked up in accordance with the mask image displayed on the display (See col. 20, lines 25-62, where the user judges whether to confirm the composed image that is displayed); an image combining unit (CPU 21 as shown in fig. 1) which combines the combination object image held by the combination object image holding unit with the base image at the combining position specified by the mask image data (the composed image includes the cut-out image (read as the combination object image) that is obtained by using a mask to cut a particular portion of the image, and the base image (image that is captured using the cutout image overlaying as shown in fig. 13)); and a recording unit (Fig. 1: 14) which records a composite image combined by the image combining unit in the composite image record section (Col. 5, lines 15-23; col. 6, line 43

– col. 7, line 5; col. 16, lines 47-63; col. 18, line 48 – col. 21, line 35; col. 23, line 60 – col. 25, line 30 in regards to fig. 17).

Iijima et al. discloses the invention in a camera but does not explicitly disclose the invention performing the composition apparatus in a mobile telephone.

However, the concept of having mobile telephone performing composition features is known as taught by Andaashu. Andaashu discloses a mobile telephone (See fig. 1: 6 and fig. 2) including an image pickup unit (Fig. 2: 20) and a base image record section (Fig. 2: 22) for recording a base image, and having an image processing function of combining a picked-up image picked up by the image pickup unit and the base image to generate a composite image (using image processor 21 as shown in fig. 2), the mobile telephone comprising: a composite image record section which records the composite image (composite images are recorded in image memory 22. See Machine English Translation, page 7, ¶ 0041); a mask image data record section (mask image data is recorded in memory 22 as shown in fig. 2. See Machine English Translation, page 7, ¶ 0035) which records a plurality of types of template image data (background image) representing template images to specify a combining position (as shown in fig. 4, the template images specify the position of the object to be photographed, i.e. in the case of the background images 1-5, the object should be placed in the center and in the case of background image 6, the object should be placed to the left of the background template) of a combination object image (image already stored in memory or being captured in real time); a reading unit (image processor 21 as shown in fig. 2) which reads the mask image data selected from among the plurality of types of mask image data from the mask image data record section (See Machine

English Translation, page 6, ¶ 0035 – page 7, ¶ 0039); a display unit (Fig. 2: 19) which displays the mask image based on the mask image data read by the reading unit on a display (See figs. 4a and 4b; see Machine English Translation, pages 6-7, ¶ 0035); a combination object image holding unit which holds the combination object image which is picked up in accordance with the mask image displayed on the display (See machine English Translation, page 7, ¶ 0040); an image combining unit (image processor 21 as shown in fig. 2; Machine English Translation, page 7, ¶ 0039-0041) which combines the combination object image held by the combination object image holding unit with the template image at the combining position specified by the template image data; and a recording unit (Fig. 2: 22) which records a composite image combined by the image combining unit in the composite image record section (Machine English Translation, page 7, ¶ 0039-0041) (Machine English Translation, page 4, ¶ 0018-0023; page 5, ¶ 0027-0030; page 6, ¶ 0033-0035; page 7, ¶ 0038-0042; page 8, ¶ 0045-0048).

Therefore, taking the combined teaching of Iijima et al. in view of Andaashu as a whole, it would have been obvious to one of an ordinary skill in the art at the time the invention was made to modify Iijima et al. by having the camera functions incorporated in a mobile telephone. The motivation to do so would have been to improve the capabilities of the camera by having the ability to transmit the captured images to other devices allowing the user to share the images with friend or to store the images in a remote location.

Regarding claim 2, the combined teaching of Iijima et al. in view of Andaashu teaches that the display unit displays a preview image generated by combining the mask image and the base image on the display when the display unit displays the mask

image on the display (See Iijima et al., col. 19, lines 15-25, see also Andaashu, Machine English Translation, pages 6-7, ¶ 0035).

Regarding claim 3, the combined teaching of Iijima et al. in view of Andaashu teaches that the plurality of types of mask image data recorded in the mask image data record section include the mask image data representing a plurality of types of mask images corresponding to the base image (See Iijima et al., col. 16, lines 47-63; col. 18, line 48 – col. 21, line 35); wherein the display unit displays the plurality of types of mask images based on the mask image data one at a time on the display until the combination object image which is picked up in accordance with the mask image is held by the combination object image holding unit (See Iijima et al., col. 16, lines 47-63; col. 18, line 48 – col. 21, line 35; col. 23, line 60 – col. 25, line 30); wherein the combination object image holding unit holds a plurality of combination object images which are picked up in accordance with the plurality of types of mask images displayed on the display (See Iijima et al., col. 20, lines 25-62, where the user judges whether to confirm the composed image that is displayed; Iijima et al also discloses storing a plurality of cut-out images to be used in the image composition function (col. 8, lines 59-67; col. 9, lines 47-62; col. 13, lines 7-15)); and wherein the image combining unit combines each of the plurality of combination object images, held by the combination object image holding unit, with the base image at the combining position based on the mask image to specify the image pickup area of the combination object image (Iijima et al discloses that the image combination can be performed to images previously stored in the flash memory with the cut-out images, this teaches that when the user selects an image that was previously synthesized as a base image to be combined with a different cut-out

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image, the combining unit is combining each of the plurality of combination object images, held by the combination object image holding unit, with the base image at the combining position based on the mask image to specify the image pickup area of the combination object image; see col. 25, line 36 – col. 26, line 64 in regards to ; see also col. 16, lines 47-63; col. 18, line 48 – col. 21, line 35; col. 23, line 60 – col. 25, line 30).

Regarding claim 4, limitations can be found in claim 2.

Regarding claim 5, the combined teaching of Iijima et al. in view of Andaashu teaches that when the combination object image which is picked up based on each of a plurality of types of image pickup areas specified by the mask image data is already held in the combination object image holding unit, the display unit combines the held combination object image with the base image at the combining position based on the mask image to specify the image pickup area for picking up the held combination object image and displays the composition image on the display (See Iijima et al., col. 20, lines 25-62, where the user judges whether to confirm the composed image that is displayed; Iijima et al. also teaches using masks having a plurality of image pick up areas to cut-out a plurality of portions of the image; see col. 11, lines 41-55, also col. 29, lines 47-60).

Regarding claim 6, the combined teaching of Iijima et al. in view of Andaashu teaches that whenever the image pickup unit picks up an image based on the mask image displayed on the display and the picked-up combination object image is held by the combination object image holding unit, the image combining unit combines the held combination object image with the base image in order (See Iijima et al., col. 20, lines 25-62; col. 18, line 48 - col. 21, line 21); and wherein after the image combining unit

combines all the combination object images with the base image, the recording unit records a composite image provided by the image combining unit in the composite image record section (See Iijima et al., col. 5, lines 15-23; col. 6, line 43 – col. 7, line 5; col. 16, lines 47-63; col. 20, lines 25-62; col. 18, line 48 - col. 21, line 21).

Regarding claim 7, the combined teaching of Iijima et al. in view of Andaashu teaches that when a picking up of the combination object image to be combined with the base image is canceled on the way, the image combining unit combines the combination object image, which is picked up by the image pickup unit and which is held by the combination object image holding unit before the picking up of the image is canceled, with the base image (Iijima et al discloses that the cut-out image that is used to create the combined image with the base image can be selected from the memory (14a) where previously stored cut-out images are stored, thus if an image being picked up of the combination object image to be combined with the base image is canceled on the way, the user can select a previously recorded cut-out image to be combined with a base image to create a new synthesized image; col. 16, lines 47-63; col. 18, line 48 – col. 21, line 35; col. 23, line 60 – col. 25, line 30).

Conclusion

8. Because new grounds of rejections have been made to reject unamended **claims 1-7**, this Office Action is made **NON-FINAL**.

Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nelson D. Hernández whose telephone number is (571)272-7311. The examiner can normally be reached on 9:00 A.M. to 5:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lin Ye can be reached on (571) 272-7372. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Nelson D. Hernández
Examiner
Art Unit 2622

NDHH
August 1, 2008

/Lin Ye/

Supervisory Patent Examiner, Art Unit 2622